

extend the "right to exclude" already granted in the patent". The Examiner's rejection is unclear. The heading of this rejection implies that the Examiner is applying a straight "double-patenting" rejection, however, the body of the rejection implies that the Examiner is applying an "obviousness" double patenting rejection. Clarification is requested.

The applicant disagrees with the Examiner's position for the following reasons. The Examiner states that the subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter. The Examiner acknowledges that the claims of the application differ from those of the patent in that the application claims require that the upper surfaces of the wedge shoe members are tapered at an angle of 49-50° as opposed to 46.5-48.5°, which was claimed in U.S. Patent No. 5,590,797. It is the Examiner's position that it would have been obvious to "adjust the components slightly for fine-tuning of the device".

The Examiner also acknowledges that the claims of the application differ from those of the patent in that the application claims require the use of a metal lubricant containing at least 2% graphite whereas the claims of U.S. Patent No. 5,590,797 required the use of a metal lubricant. It

is the Examiner's position the it would have been obvious to one of ordinary skill in the art to "understand that since the prior art recited a preselected metal lubricant, it is broader than the instant claims and therefore would encompass a metal lubricant with graphite".

If the Examiner is applying a straight "double-patenting" rejection, then his attention is directed to MPEP 804 (II), which discusses the difference between "domination" versus "double patenting". MPEP 804 (II) (A) further states that double patenting does not exist in the case wherein a "broader" limitation is recited in the issued patent and a "narrower" limitation is now being defined in the claims. See the recitation that recites "the invention defined by a claim reciting a compound having a "halogen" substituent is not identical to or substantively the same as a claim reciting the same compound except having a "chlorine" substituent in place of the halogen because "halogen" is broader than "chlorine". Thus, the Examiner's argument that "since the prior art recited a preselected metal lubricant, it is broader than the instant claims and therefore would encompass a metal lubricant with graphite" is not a basis for rejection of the claims under the judicially created doctrine of double patenting. Furthermore, 35 USC 101 does not allow one to "adjust" the claimed range

limitations for "fine-tuning" **outside** of the claimed range in the patent in order to overcome the claimed limitations of the application.

If the Examiner is applying an "obvious-type double-patenting" rejection, then the Examiner has failed to present a prima-facie case of obviousness as he has failed to cite any art in support of his obviousness conclusions. There is no suggestion in the ('797) patent to "fine-tune" outside of the claimed range. Rather, one having ordinary skill in the art would be motivated to "fine-tune" within the disclosed and claimed range. Furthermore, one having ordinary skill in the art would not be motivated to add 2% graphite to the insert members of the present invention just through the disclosure of the ('797) patent to use metal insert members. As stated above, the Examiner has failed to cite any additional art in support of his obviousness conclusions.

For the reasons set forth above, it is respectfully requested that the rejection of claims 1-17 under the judicially created doctrine of double patenting over claims 1, 3, 5, 7-10 and 12 of U.S. Patent No. 5,590,797 be withdrawn.

Claims 1-21 stand rejected under 35 USC 103(a) as being obvious over the teachings of Duffy et al (5,590,797). It is the Examiner's position that since the change in angle is

minimal, it would have been obvious to one of ordinary skill in the art to adjust the components slightly for fine-tuning of the device. The Examiner also states that it would have been obvious to one having ordinary skill in the art to understand that since the prior art recites a pre-selected metal lubricant, this limitation is broader than the instant claims and therefore would encompass a metal lubricant with graphite.

The Examiner's attention is directed to the background portion of the specification at pages 4-5 wherein U.S. Patent No. 5,590,797 is discussed in detail. While it was found that the ('797) design resulted in an improved friction clutch draft gear assembly than those previously in use, it was determined that this particular design did not satisfy the requirements as defined in AAR Specification M-901-G. It was determined during testing of Super Mark 50's, with rusted friction packs, assembled with H-911 brass inserts, that the units tested had reaction force spikes higher than 500K. This resulted in hammer capacities of less than 36,000 ft/lbs. When tested on the test track, the same super Mark 50 reached the 500K reaction force levels well before the 5-MPH requirement for a G specification draft gear. It was determined through extensive testing and evaluation that slightly increasing the center wedge shoe angle increases the clamping force on the friction pack. It was

further determined that applying inserts containing 2% graphite reduces unwanted reaction force spikes. The combination of these modifications increases the overall performance of the draft gear without adversely affecting its operation and meets the requirements as defined by AAR Specification M-901-G. Thus, while it might seem "obvious" to the Examiner to "fine-tune" the draft gear disclosed in the U.S. Patent No. 5,590,797 such was not obvious to the inventors of this patent. An angle range of 46.5-48.5 is recited in the patent. It is the Examiner's position that one would have been motivated to "fine-tune" their draft gear and/or to "round-up" the upper end-point of the cited patent's range to 49 degrees. It is the Applicant's position that the Examiner is using impermissible hindsight to make such a conclusion. If one having ordinary skill in the art were simply "fine-tuning" their draft gear, then he/she would be motivated to "fine-tune" within this range. There is no suggestion within the patent that would suggest one to "fine-tune" outside of the range or "round-up" from the upper end-point of the range claimed in the ('797) patent.

With respect to the claimed limitation of inserts containing 2% graphite, the Examiner's basis for determining obviousness in that the disclosure of metal inserts within the ('797) patent is "**broader**" than the particularly claimed 2%

graphite inserts would **"encompass"** the claims of the present invention is not a valid test of obviousness. The claims of the present invention, which require inserts containing 2% graphite, are **narrower and more specific than those of the ('797) patent**. The assignee of the present invention has **improved** the draft gear of the ('797) patent and is claiming these improvements in the narrower claims of the present invention. The burden of proof is on the Examiner to show that the use of the more specifically claimed inserts is obvious. Applicant further argues that since the claimed amount of graphite is "such a small amount, this could easily be found in a metal lubricant". The art of record does not support this argument. The Examiner has failed to cite any art that teaches a metal lubricant containing 2% graphite in a draft gear as is being claimed. The Examiner is using hindsight to reconstruct the invention and has thus failed to render the claims of the present application obvious.

In the Final Office Action, the Examiner argues that "it appears, based on applicant arguments, that the angle of the wedge shoe was claimed based on a constantly changing AAR specification. This argument is not understood. The Applicant never argued that the AAR specifications were "constantly changing". Applicant argued that the prior art didn't satisfy

the AAR specifications. Extensive testing and modifications of the draft gear of ('797) patent resulted in the draft gear of the present invention, which does meet these standards. However, even if "constantly changing AAR specifications" were occurring, such an argument is irrelevant. The art of record still fails to meet the limitations of the claims.

In view of the forgoing arguments, it is requested that the final rejection of claims 1-21 under 35 USC 103(a) over the teachings of Duffy et al (5,590,797) be withdrawn, as this patent fails to render claims 1-21 obvious.

Conclusion

In view of the foregoing arguments and amendments, Applicant believes that the application meets all applicable statutory and regulatory requirements. Accordingly, Applicant respectfully requests allowance of all claims remaining in the application.

If the Examiner has any questions regarding this amendment and/or believes that a telephone interview would assist in the advancement of this case to allowance, he/she is invited to contact the undersigned Agent for Applicant.

Respectfully submitted,

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